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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,958	02/11/2004	Charles J. Johansen JR.	250-181	4241
47888	7590	10/06/2005		
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER MARCANTONI, PAUL D	
			ART UNIT	PAPER NUMBER

1755

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,958

Applicant(s)

JOHANSEN ET AL.

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/25/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11,13-21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,13-21 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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Applicant's arguments filed 7/25/05 have been fully considered but they are not persuasive.

Obviousness Type Double Patenting:

Claims 1,2, 4-11, 13-21, and 23-27 remain rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 6,692,565 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because both would appear to teach the same or overlapping invention as claimed for the instant invention.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The applicants did not submit a terminal disclaimer so thus the ODP rejection above stands.

35 USC 102:

Claims 1,2, 4-11, 13-21, and 23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Price et al. '404, Tanner '785 or '976, Tucker et al. '208, GB 1122210 (Heilman-abstract only), or IN 162194 (Saboo).

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Zatsepin et al., Bozhenov et al., Ponomarev et al., Aristov et al. (SU 1016342-abstract only); or Sirazhiddinov et al. (SU 1539178-abstract only) have been withdrawn because the teachings are redundant with that of the remaining above cited references.

All of the above cited references teach making colored cement by adding a pigment before heating or sintering to form the clinker thus anticipating the instant invention. The addition of water and an inert filler such as aggregate or sand would have been an obvious design choice for one of ordinary skill in the art because these components are merely conventional additives added to cement and concretes. The claimed method is routine mixing of components. The applicants selection of a color would have been understood because a pigment was already chosen to form the desired color for the cement product.

35 USC 103:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2, 4-11, 13-21, and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al. '404, Tanner '785 or '976, Tucker et al. '208, , GB 1122210 (Heilman-abstract only), or IN 162194 (Saboo) alone or in view of Johansen Jr et al. '315 or 665.

The primary references teach colored cement made by mixing a pigment prior to sintering to form a clinker. Not all references necessarily teach addition of conventional

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additives claimed in the instant invention even though their addition is old in the art. Johansen has been combined with the primary references to show that the addition of other conventional additives to a pigmented cement would have been old and obvious to one of ordinary skill in the art. The claimed method is the routine mixing of the components within the teaching of the prior art. . The applicants selection of a color would have been understood because a pigment was already chosen to form the desired color for the cement product. It is also noted that the Johansen secondary references teach the selection of a color for the desired final product would have been within the obvious design choice of one of ordinary skill in the art (see claims to Johansen references).

Response:

The applicants indicate that they amended their independent claims 1, 9, and 10 to include the limitation that the inert filler comprises up to 100 weight percent of a man made pigmented inert filler (also how much % color remaining if immersed in HCl or sodium hypchlorite solution). The applicants thus argue that the prior art does not teach the combination of a colored cement produced from clinkers formed with pigment prior to sintering and an inert filler comprising up to 100 weight percent of a man made pigmented inert filler. In rebuttal, the prior art does teach it is old and well known in the art to add pigment prior to the formation of a cement clinker to obtain color stability for the cement. The applicants only difference over the prior art would appear to be that the prior art does not also teach the combination which includes a man made pigmented

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filler. In rebuttal, the applicants' usage of "up to" claim language includes zero as a lower limit and thus the applicants claimed man made pigmented filler can be zero weight percent. The independent claims thus read only upon an inert filler. See *In re Mochel*, 470 F 2d 638, 176 USPQ 194 (CCPA 1974).

Further, Price et al. teach that other waste materials such as those listed in lines 1-25 of claim 4 which include pigments, latex paint wastes, slag fines, clay fines, pyrite ashes, cinder fines, lime kiln dust are inclusive and read upon man made inert filler. Even a material such as pyrite ash can be considered a man made pigment because it is ash that is made by man and will impart a color to the cement product. A pigment is a material that imparts a color or a coloring agent.

It is also noted that all rejections under 35 USC 112 second paragraph have now been withdrawn. The references crossed through and not considered on the most recently submitted PTO-1449 were not considered because the reference was not present in the scanned material in the submitted documents by applicants. Applicants may submit these documents for consideration still.

Also, the abstract references to Kawase et al. (JP 60251162), Nakayama et al. (JP 61040861), Wakisaka et al. (JP 09316371), or Naito (JP 52082923) could also have potentially been used in the rejection of claims above. These were references submitted by applicants on their most recent PTO-1449. The reason they could be used in the rejection is that they teach "white" Portland cement and a colored aggregate such as colored sand (man made inert filler) that are the components of applicants' instantly claimed invention. The applicants have defined "white" cements as an

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uncolored cement by their own definition. It is assumed that they hold the position that white is not a color. The examiner disagrees with this definition and even refers applicants to Heilmann (GB 1122210-abstract) wherein he teaches adding chromium oxide to obtain a white color and to mask the naturally occurring color of gray to brown. The examiner holds that white is a color and a pigment (chromium oxide in this case for white Portland cement) needs to be added to maintain a white color or else it would be gray or brown.

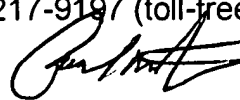
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be

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obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
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